

**REMARKS**

Claims 1-8 and 39-61 are currently pending in the subject application and are presently under consideration. Claim 50 has been amended to further emphasize various distinguishing features, and new claims 59-61 have been newly added, support for which can be found at least at page 9, lines 1-2 and page 11, lines 13-16 of applicant's specification. A version of all pending claims can be found at pages 2-8 of the Reply.

Applicant's representative kindly thanks the Examiner for being mindful of the lengthy prosecution with regard to the subject patent application as discussed at page 3 of the Office Action (dated January 23, 2008). Accordingly, if after reviewing the comments and amendments provide herewith, the Examiner believes a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's representative.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

**I. Rejection of Claims 1-8 and 39-61 Under 35 U.S.C. §103(a)**

Claims 1-8 and 39-61 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ephrati, *et al.* (US 7,296,001, hereinafter referred to as "Ephrati"). Withdrawal of this rejection is respectfully requested for at least the following reasons. Ephrati does not teach or suggest all the claimed features.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. In addition, there must be a reasonable expectation of success to make the proposed combination. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR v. Teleflex*, 550 U.S. \_\_\_, 127 S. Ct. 1727 (2007) *citing In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006).

The claimed subject matter relates in part to a multiple criterion buying and selling model that can correlate criteria defined by a buyer with criteria defined by the sellers. *The model can allow certain selling/buying criteria to be pre-selected prior to negotiating* (e.g., price, quality, warranty). (See pg. 9, ll. 1-2). The model can also allow the buyer or seller to enter offering/ordering criteria, which can be a value or range for the selling/buying criteria (see e.g., pg. 8, line 27 – pg. 9, line 4; FIGS 4a-b). Thus, rather than waiting for sellers to determine if they can meet all buying criteria before making an offer, deals that *match in terms of offering/ordering criteria* can be output in real time based upon the input criteria of one or both parties. In addition, sellers can be informed of buying criteria that does not match their own seller criteria. For example, the sellers of a particular good or service can define a set of minimum inputs and other criteria such as quality ratings of the goods (see page 11, lines 4-7; page 16, lines 15-21; Fig. 8b, element 303), while the buyers can enter criteria that is important to them such as warranty, of which the sellers may not have listed in their own criteria, or even be aware it would be of interest to buyers (see page 2, lines 24-25). Hence, the model can inform sellers of buyers' input criteria that the sellers did not list as their own criteria (see page 11, lines 13-15), and output deals in real time based upon the same or other criteria. In particular independent claim 47 (and similarly independent claims 1, 40, 50, 51, 52) recites, “*matching at least one deal of the plurality of deals that meets at least one buyer defined price and non-price buying criteria, the non-price criteria including at least one distribution criterion.*” Ephrati does not teach or suggest these features.

Rather, Ephrati generally relates to providing a negotiation platform for buyers and sellers. (See Abstract). More specifically, Ephrati discloses a negotiation facilitator system (see FIG. 1, element 110) that can facilitate communication links (see FIG. 4, element 120) between a buyer and a seller so that these parties can negotiate terms of a potential sale of a good. In particular, the negotiation facilitator receives an offer from either a buyer or seller (see col. 4, ll. 46-49; col. 8, ll. 3-5), and posts the offer to allow an interested party to accept the offer or make a counter offer, with the negotiation facilitator enforcing a few rules that facilitate orderly transactions. (See FIG. 8). The offer can be either directed to a single, identified party who is the only party who can respond to the offer, or be undirected in which case either (1) all participants on the system can respond to the offer; or (2) those that can respond are based upon

a list of eligible and/or non-eligible parties. (See col. 6, ll. 45-57; col. 14, ll. 1-3). In essence, Ephrati is a computer-based tool that can be utilized to negotiate a sale, but (i) only *after* the offeree has done all the legwork of scanning through the posted offers to find what he or she wants to buy; or (ii) only *after* the offeror has personally selected the party(ies) to whom to make the offer. Case (i) is tantamount to a buyer scanning the want ads of a newspaper, finding a desired item, and then employing a computer-based system (Ephrati) to perform the negotiation with the seller. Case (ii) is similar to a seller identifying a buyer and to whom to offer a product and then utilizing a computer-based form of negotiation to solicit the buyer rather than, say, mail or a telephone. Accordingly, Ephrati, which discloses an offers posting platform with a negotiation mechanism, is materially distinct and considerably inapplicable to the claimed subject matter, which can allow for pre-selection of suitable criteria *prior* to negotiation. Most particularly, Ephrati does not teach or suggest “*matching at least one deal of the plurality of deals that meets at least one buyer defined price and non-price buying criteria*, the non-price criteria including at least one distribution criterion.”

In more detail, Ephrati provides a platform wherein offers can be posted and viewed as well as access to the negotiation facilitator that is intended to replace traditional face-to-face negotiation after the parties to the potential sale are established. Once the active link is created between the established parties (see col. 7, ll. 25-29), the negotiation proceeds based upon rules enforced by the negotiation facilitator (see col. 13, ll. 11-15). Accordingly, it is readily apparent that Ephrati does not contemplate, teach, or suggest “*matching at least one deal of the plurality of deals that meets at least one buyer defined price and non-price buying criteria*, the non-price criteria including at least one distribution criterion.” Rather, Ephrati expressly teaches away from such a feature by requiring an offeror to designate in advance the parties who can receive the offer and/or requiring the offeree to select interesting offers from among all offers.

It is self-evident that in the case of a directed offer there is no matching, as the offeror expressly designates to whom an offer will be visible. On the other hand, for an undirected offer, the rules (e.g., static rules) are still defined by the offer (see col. 13, ll. 20-21), and thus designated by the offeror in advance (e.g., eligibility/non-eligibility selected by offeror). Hence, while Ephrati appears to be largely irrelevant to the subject claims, even in the least irrelevant case, such requires the offeree to sort through all offers before any indication of interest in the

offer can be known. In addition, Ephrati expressly discloses an architecture that establishes the communication link (e.g., link 120) before any acceptance or counteroffer can be transmitted. (See col. 7, ll. 20-41). In fact, at least until the time in which the link is established, the negotiation facilitator has no information about the product attributes desired by the offeree (e.g., until a counteroffer is made). Thus, clearly, not only does Ephrati not teach or suggest matching or correlating offers based upon user-inputted criteria (e.g., from **both** parties) as claimed, it would be impossible as taught for Ephrati to do so. Thus, while the crux of Ephrati is directed to a model to facilitate negotiation, the subject claims can match buyers and sellers based upon selected criteria **prior** to negotiation. For at least these reasons, this rejection should be withdrawn.

Furthermore, at page 2 of the Office Action (dated January 23, 2008), the Examiner concedes that “Ephrati does not explicitly disclose a service and distribution criteria,” but suggest such would have been obvious to one of ordinary skill in the art in view of an Official Notice from the July 17, 2007 Office Action. The Examiner further argues that deeming these shortcomings as obvious is proper because applicant did not traverse the previous Official Notice. The latter assertion by the Examiner is in err, as applicant did in fact traverse the previous Official Notice. The said traversal can be found at pages 12 and 13 of the Reply to Office Action filed on October 17, 2007, and is reiterated here yet again, *infra*. Thus, for yet another reason, this rejection should be withdrawn.

Applicants respectfully traverse the aforementioned Official Notice and request that the Examiner cite a reference in support of this position pursuant to MPEP 2144.03 if this rejection is to be maintained. Furthermore, the indicated Official Notice appears to have no adequate relationship to the subject claims and is therefore moot. In particular, even assuming that the Examiner’s assertions are capable of instant and unquestionable demonstration as being well-known, asserting that a particular feature is well-known outside the context of and without the recited and inherent relationships of all that is claimed is not adequate for a showing of obviousness. Hence, assuming as fact that distribution criteria has been common knowledge in the electronic marketing art does not necessarily imply that well-known distribution criteria is or could be reasonably considered to be the non-price criteria of the subject claims. Moreover,

there does not appear to be any rational underpinning to support combining such distribution criteria (even if well-known) with a system for trading bonds online as taught by Kim.

### **CONCLUSION**

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [GEDP106US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,  
AMIN, TUROCY & CALVIN, LLP

/David W. Grillo/  
David W. Grillo  
Reg. No. 52,970

AMIN, TUROCY & CALVIN, LLP  
24<sup>TH</sup> Floor, National City Center  
1900 E. 9<sup>TH</sup> Street  
Cleveland, Ohio 44114  
Telephone (216) 696-8730  
Facsimile (216) 696-8731